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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,041	12/20/2000	Ryusuke Yamaguchi	00908/LH	7945

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EXAMINER

HERNANDEZ, NELSON D

ART UNIT PAPER NUMBER

2612

DATE MAILED: 06/09/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,041

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Nelson D. Hernandez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6-8, 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 20000-50133 A, hereinafter "prior art" (reference signs below are based on machine translation of the JP patent, furnished in PTO-892).

Re claims 1-2, 13, the prior art reference teaches a portable image capturing device (Fig. 2, i.e., wrist-watch camera device), comprising: a device body (2), an image capturing portion i.e., "camera" portion (30, ¶0011) and an optical communication portion (Fig. 4: TRANSMITT/RECEIV, also ¶0011 and 0019), which are provided on the device body, and a transparent covering member (28, ¶0011) for covering the camera.

The transparent covering member (28) of the prior art reference covers only the camera (30) and does not cover both the camera portion and the optical communication portion wherein the two portions are disposed adjacent to one another, and wherein an optical shielding structure is provided disposed between the two portions to prevent interference between the two as recited in claims 1 and 2. Furthermore, the prior art reference is silent as to where the optical communication portion is disposed relative to the camera portion, but it is recognized that the two portions are disposed within the body (2) of the wrist-watch camera device.

Nevertheless, Official Notice is taken that it would have been obvious to one skilled in the art to provide a transparent covering member that covers both the camera portion and the optical communication portion if the two portions are merely disposed adjacent to one another by design, and one skilled in the art would have been motivated to provide an optical shielding structure disposed between the two portions to prevent interference because interference between the two portions would likely to happen.

Re claim 3, the prior art reference does not teach that the optical shielding structure is provided by printing. However, Official Notice is taken that it is notoriously well known and obvious to provide a shielding structure by printing as one of the alternatives of shielding to prevent interference between an imaging device adjacent to a light source (e.g. infrared light).

Re claims 6 and 8, the prior art reference is silent about the transparent covering member comprises a material having a filtering property to a light with specific wavelength, and it is a concave lens as claimed. However, it is obvious and expected that the lens (28) has filtering property to a specific wavelength without explicitly recitation. As for the concave lens characteristic, Official Notice is taken that it is well known and use in the art to use a concave lens or any type of well known lenses with an imaging device as claimed. For example, a convex lens may be use for focusing light from a distant source to a point and a concave lens may be used for diverging a beam of light from a distant source.

Re claim 7, the prior art reference teaches the transparent covering member is a lens (28) disposed at a position corresponding to the optical axis for image capturing from the image-capturing portion (See also ¶0010, ¶0011 and ¶0019).

Re claim 11, the prior art reference teaches the image capturing portion and the optical communication portion are provided in the device body, but is silent about the optical axis for image capturing from the image capturing portion is approximately perpendicular to the optical axis for communication from the optical communication. Even though the prior art reference is silent about the specific orientation of the imaging device relative to the optical communication device, it does teach that the transmission of the optical communication device can be performed through the crystal glass (10) or the lens (28). (See also detailed description in translation, ¶ 0019).

Therefore, it would have been obvious to one of ordinary skilled in the art to dispose the optical communication device at any orientation with respect to the imaging device, inclusive of being perpendicular to another as claimed. Furthermore, having the optical communication device placed so as to transmit data through the crystal glass of the watch as taught by the prior art reference would have necessitated the optical communication device oriented approximately perpendicular to the imaging device.

Re claim 12, the prior art reference teaches a wrist watch camera device (fig. 2) that comprises a covering member (10, i.e., transparent face of watch) wherein the device houses an image-capturing portion, an optical communication portion, and a data display portion (52).

Re claim 14, in the prior art reference, the wristband can be rotated to be overlapped on the rear surface of the device body (Figs. 1 and 2 show bands that can be rotated so as to be overlapped on the rear surface of the device body).

3. Claims 4-5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dinger, JP 2000050133 A in view of Roustaei, US 5756981.

Re claim 4, the prior art reference teaches substantially as recited in claims 1-2, but fails to teach an optical shielding structure provided on the device body as claimed.

However, Roustaei teaches an optical device (Fig. 17) having an imaging device (Fig. 17: 1720) disposed adjacent to two light emitting devices (LEDs, Fig. 17: 1702 and 1704) wherein said imaging device and light emitting devices are enclosed in dark rooms (Figs. 17: 1708, 1709 and 1716) to avoid any interference from the light emitting devices to the imaging device (Col. 11, lines 53-64). The optical shielding structure is provided on the device body (Fig. 17: 1708, 1709 and 1716 also Col. 11, lines 53-64).

Therefore, taking the combined teaching of the prior art and Roustaei as a whole, it would have been obvious to one skilled in the art to have been motivated to provide an optical shielding structure that is part of a device body as claimed for the advantage of filtering and/or anti-reflection properties as suggested by Roustaei (col. 4, lines 33-36).

Re claim 5, the prior art reference does not teach that the optical shielding structure comprises a rib, which serves as a securing member for the transparent covering member to the device body and as a separator, in a case where the camera portion and the optical communications portion are adjacent to each other. However,

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Official Notice is taken that it would have been obvious and necessitated to provide a rib as claimed to secure the transparent covering member and to separate the two portions so as to avoid any interference in the imaging device caused by the optical communication device.

Re claim 9, the prior art reference teaches that a portion at a position corresponding to the optical axis for image capturing from the image capturing portion of the transparent covering member comprises a transparent material, but does not teach a member having a filtering property to a light with specific wavelength is provided at a position corresponding to the optical axis for communication from the optical communication portion.

However, Roustaei teaches windows (Fig. 5: 524 and 525) covering the infrared LEDs wherein said windows may include a filter or an anti-reflection coating (Col. 4, lines 33-36).

Therefore, taking the combined teaching of the prior art reference in view of Roustaei as a whole, it would have been obvious to one of ordinary skilled in the art to have been motivated to incorporate a filter member or an anti-reflection coating at the position of the optical communication device with the motivation of avoid any interference in the imaging device caused by the optical communication device.

Also, the prior art reference does not teach that the transparent covering member is formed as a body. However, it teaches that the case (Fig. 2: 2) can be formed with a plastic material according to the injection-molding technique known well (See detailed description in translation, ¶ 0010).

Therefore, it would be obvious to one of ordinary skilled in the art to have been motivated to make the transparent covering as a body to cover the elements of the image-capturing device as claimed. The motivation to do so would allow better visibility of the members enclosed in the image-capturing device.

Re claim 10, the prior art reference does not disclose a sealing member having a filtering property to a light with specific wavelength is disposed between the transparent covering member and the optical communication portion.

Roustaei teaches windows (Fig. 5: 524 and 525) covering the infrared LEDs wherein said windows may include a filter or an anti-reflection coating, which serves as a sealing member with filtering property (Col. 4, lines 33-36).

Therefore, taking the combined teaching of the prior art reference in view of Roustaei as a whole, it would have been obvious to one of ordinary skilled in the art to have been motivated to incorporate a filter member or an anti-reflection coating at the position of the optical communication device as a sealing member. The motivation to do so would help the imaging device to avoid any interference in the imaging device caused by the optical communication device.

Contact

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson D. Hernandez whose telephone number is (703) 305-8717. The examiner can normally be reached on 8:30 A.M. to 6:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy R. Garber can be reached on (703) 305-4929. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nelson D. Hernandez
Examiner
Art Unit 2612

NDHH
May 3, 2004


VULE
PRIMARY EXAMINER